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KNOBBE MARTENS OLSON &  
BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

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**OFFICE OF PETITIONS**

|                            |   |                         |
|----------------------------|---|-------------------------|
| In re Application of       | : |                         |
| Zhimin Lu                  | : | DECISION ON APPLICATION |
| Application No. 09/870,393 | : | FOR                     |
| Filed: May 29, 2001        | : | PATENT TERM ADJUSTMENT  |
| Atty Docket No. ASMEX.282A | : |                         |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b)", filed August 8, 2005. Applicant requests that the initial determination of patent term adjustment be corrected from zero (0) to eight hundred forty-five (845) days<sup>1</sup>.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is eight hundred seventeen (**817**) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On May 9, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment

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<sup>1</sup> In the first line of the statement of facts, applicant submits that the correct patent term adjustment (PTA) is 817 days. However, throughout the petition, applicant argues that the PTA is 845 days.

(PTA) to date is 0 days. On August 8, 2005, applicant timely<sup>2</sup> submitted this application for patent term adjustment.

Applicant submits that the adjustment of 0 days has been erroneously calculated, based on an incorrect date assigned to the Patent Term History listings for "Statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant" and "Payment of additional filing fee."

Applicant states that their response to the Notice to File Missing Parts of Application mailed August 2, 2001 was received by the PTO on January 23, 2002, which was 82 days more than three months after mailing of the Notice to File Missing Parts, and should have been received by December 26, 2001, which was only 54 days more than three months after mailing of the Notice to File Missing Parts.

Applicant argues that the December 26, 2001 date should be used in calculating their delay, and thus, the period of delay is 54 days. In support of this argument, applicant cites the occurrence of a Postal Service delay because the mailing was during the period when anthrax was suspected in the mail.

Applicant states that in the ordinary course, the mailing would be expected to be received within three business days. In light of the intervening holiday, applicant states the mailing should have been received on December 26, 2001, rather than the January 23, 2002 date acknowledged by the Patent Office.

Applicant submits that the patent issuing from this application is not subject to a terminal disclaimer.

Applicant's arguments have been considered, but not found persuasive as to using a December 26, 2001 date for calculating the period of reduction pursuant to § 1.704(b). The circumstances of the Postal Service delays and the relief afforded to affected individuals was addressed in an OG Notice dated January 15, 2002 (1254 OG 92). However, the provisions for reinstating patent term adjustment applied only to replies mailed on or after October 13, 2001 and no later than December 1, 2001. A review of the application history confirms that the response at issue was mailed with a certificate of mailing on December 21, 2001, but was not received by the Patent Office until January 23, 2002. As the response was mailed on December 21, 2001, the provisions of the OG Notice are not applicable.

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<sup>2</sup> PALM records indicate that the issue fee payment was also received on August 8, 2005.

Otherwise, the Office on application for patent term adjustment under § 1.705(b) does not reinstate patent term based on such an expected date of receipt. The date the reply was actually filed is used in calculating the patent term adjustment. Specifically, 37 C.F.R. § 1.704(b) provides, in pertinent part, that:

..., an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed.

37 CFR 1.703(f), further provides that "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. See also, Comment 10, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000). As stated in MPEP 2731:

The date indicated on a certificate of mailing is used only to determine whether the correspondence is timely (including whether any extension of the time and fee are required) so as to avoid abandonment of the application or termination or dismissal of proceedings. The actual date of receipt of the correspondence in the Office is used for all other purposes. See 37 CFR 1.8(a). Thus, while the date indicated on any certificate of mailing or transmission under 37 CFR 1.8 will continue to be taken into account in determining timeliness, the date of filing (37 CFR 1.6) will be the date used in a patent term adjustment calculation. Applicant may wish to consider the use of the "Express Mail Post Office to Addressee" service of the United States Postal Service (37 CFR 1.10) or facsimile transmission (37 CFR 1.6(d)) for replies to be accorded the earliest possible filing date for patent term adjustment

calculations. Alternatively, applicant may choose to mail correspondence with sufficient time to ensure that the correspondence is received in the Office (and stamped with a date of receipt) before the expiration of the three-month period. ...

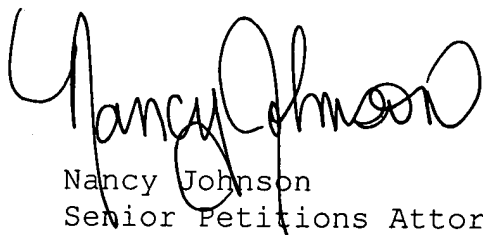
Nonetheless, the period of reduction is not 900 days. In this instance, the period of reduction is 82 days, counting the number of days beginning on the day after the date that is three months after the date of mailing of the Notice to File Missing Parts, November 3, 2001, and ending on the date the reply was filed, January 23, 2002.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is eight hundred seventeen (817) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office of Patent Publication has been advised of this decision. The application is, thereby, forwarded to the Office of Patent Publication so that the patent can be issued. The patent term adjustment indicated on the patent will include any patent term adjustment accrued for Office delay in issuing the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is stylized with a large, looping "N" and a cursive "Johnson".

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Attachment: Copy of Revised PAIR Screen